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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,816	08/09/2001	Peng George Wang	10114-009	4659

7590

09/08/2003

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EXAMINER

KHARE, DEVESH

ART UNIT

PAPER NUMBER

1623

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,816

Applicant(s)

WANG ET AL.

Examiner

Devesh Khare

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-20, drawn to a sugar modified linsidomine compound and a pharmaceutical composition containing the sugar modified linsidomine compound, classified in class 536 and 424, subclass various.
 - II. Claims 21-24, drawn to a method of generating nitric oxide by contacting a sugar modified linsidomine compound with a glycosidase, classified in classes 514 and 435, subclass various.
 - III. Claims 25-27, drawn to a method of generating peroxynitrile anion by contacting a sugar modified linsidomine compound with a glycosidase, classified in class 514 and 435, subclass various.
 - IV. Claims 28-33, drawn to a method of selectively destroying a cell by contacting a sugar modified linsidomine compound with the said cell and a glycosidase, classified in class 514 and 435, subclass various.

The inventions are distinct, each from the other because of the following reasons:

Groups I and II-IV are related as product and process of making. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for making the product as claimed can be practiced with another materially different process or (2) the product as claimed can be made in a materially different process of

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making that product (MPEP § 806.05(h)). In the instant case the claims are drawn to methods of generating nitric oxide and peroxy nitrile anion and selectively destroying a cell, indicating that the product (the compound/composition of Group I) can be used by a materially different method.

Inventions II/III, II/IV and III/IV are unrelated to one another. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01).

Group II is drawn to a method for generating nitric oxide by contacting a sugar modified linsidomine compound with glycosidase, which is unrelated to a method of generating peroxy nitrile anion by contacting a sugar modified linsidomine compound with a glycosidase, of Group III.

Group II is drawn to a method for generating nitric oxide by contacting a sugar modified linsidomine compound with glycosidase, which is unrelated to a method of selectively destroying a cell by contacting a sugar modified linsidomine compound with the said cell and a glycosidase, of Group IV.

Group III is drawn to a method of generating peroxy nitrile anion by contacting a sugar modified linsidomine compound with glycosidase, which is unrelated to a method of selectively destroying a cell by contacting a sugar modified linsidomine compound with the said cell and a glycosidase, of Group IV.

Although the inventions are classified in the same class and sub-class, searching the four groups of inventions constitutes a burdensome search, as a thorough search

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comprises a search of foreign patents and non-patent literature as well as the appropriate U.S. patent classifications. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their divergent subject matter, restriction for examination purposes as indicated is proper. It is noted that the four independent and distinct inventions would indeed impose an undue burden upon the examiner in charge of this application.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143). If applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims, which depend from or otherwise include all the limitations of the allowable product claim will be rejoined. (MPEP § 821.04)

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Devesh Khare whose telephone number is (703)605-


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1199. The examiner can normally be reached on Monday to Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, Supervisory Patent Examiner, Art Unit 1623 can be reached at 703-308-4624. The official fax phone numbers for the organization where this application or proceeding is assigned is (703) 308-4556 or 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Devesh Khare, Ph.D.,JD(3Y).
Art Unit 1623
September 4, 2003



JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600